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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,893	03/22/2004	Verlyn H. Paulson	54396US012	1799

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EXAMINER
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SIMONE, CATHERINE A

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 02/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/805,893	<b>Applicant(s)</b> PAULSON ET AL.	
	<b>Examiner</b> Catherine Simone	<b>Art Unit</b> 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 20 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Repeated Rejections***

1. The 35 U.S.C. 102 (e) rejection of claims 20 and 26 as anticipated by Nilsen et al. is repeated for the reasons previously set forth in the Office Action mailed 8/23/05, Pages 2-3, Paragraph #2.
2. The 35 U.S.C. 103 rejection of claims 20 and 26 over Bacon et al. is repeated for the reasons previously set forth in the Office Action mailed 8/23/05, Pages 3-4, Paragraph #4.

### ***Response to Arguments***

3. Applicant's arguments filed 11/22/05 have been fully considered but they are not persuasive.

Applicants argue "Nilsen et al. does not teach a microstructured composite sheeting, where any seam present in the array has a width of about 0.0025 mm to about 0.2 mm on a patterned side. Instead, the teachings of Nilsen et al. cited by the Office Action describe the space (s) between edges of matched prisms in a retroreflective element 10. See Nilsen et al., Fig. 6. In other words, the teachings of Nilsen et al. cited by the Office Action do not describe seams in sheetings formed, e.g., by weld lines of a mold. Because Nilsen et al. does not teach each and every element of claims 20 and 26, such claims are novel over Nilsen et al."

First, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., seams...formed by weld lines of a mold) are not recited in the rejected claim(s). Although the

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claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Second, it is to be pointed out that the recitation “formed by weld lines of a mold” is a method of production and hence does not determine the patentability of the product itself. The method of forming the product is not germane to the issue of patentability of the product itself. MPEP 2113.

Finally, it is to be pointed out that according to Merriam-Webster’s Collegiate Dictionary, “seam” is defined as *a line, groove, or ridge formed by the abutment of edges*. In Fig. 5 of Nilsen et al., a line and V-shaped groove (30, 32 and 34) is shown between elements 39a and 39b after the elements are connected together. In Fig. 6 of Nilsen et al, the space (s) corresponds to the line and V-shaped groove formed between elements 39a and 39b shown in Fig. 5. Therefore, the length (width) of the space (s) also corresponds to the length (width) of the line and V-shaped groove formed between elements 39a and 39b. Thus, Nilsen et al. clearly teaches a microstructured composite sheeting where any seam present in the array has a width of about 0.0025 mm to about 0.2 mm on a patterned side as recited in claims 20 and 26.

Furthermore, Applicants argue “Bacon et al. does not teach or suggest a sheeting having such a seam. The teachings of Bacon et al. cited by the Office Action describe the gaps between discrete cube corner segments that are bonded together through a conformable carrier layer. Bacon et al. teaches that these discrete cube corner elements can be formed, e.g. by fracturing the sheeting using a tool. This teaching of Bacon et al. is in direct contrast to claims 20 and 26 of the present application, which recites seams in sheetings that can be formed, e.g. from weld lines on the sleeve used to make such sheetings.”

First, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., seams...formed from weld lines on the sleeve used to make such sheetings) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Second, it is to be pointed out that the recitation "formed from weld lines on the sleeve used to make such sheetings" is a method of production and hence does not determine the patentability of the product itself. The method of forming the product is not germane to the issue of patentability of the product itself. MPEP 2113. Finally, it is to be pointed out again that according to Merriam-Webster's Collegiate Dictionary, "seam" is defined as *a line, groove, or ridge formed by the abutment of edges*. In Figs. 1 and 2 of Bacon et al., gaps 50 are shown as lines formed between discrete cube corner elements 12 in the microstructured sheeting and therefore are seams. Therefore, Bacon et al. clearly teaches a microstructured composite sheeting having seams.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571)272-1501. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Catherine A. Simone  
Examiner  
Art Unit 1772  
January 23, 2006



HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

1/30/06